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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER ELALLAM, AHMED	
			ART UNIT 2616	PAPER NUMBER
			NOTIFICATION DATE 01/08/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/032,427

Applicant(s)

KOPONEN ET AL.

Examiner

AHMED ELALLAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-24 and 26-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-20, 23, 24, 26, 27, 32 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 21, 22, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to Amendment filed on 09/25/2007.

Claims 1-15, 17-24, 26-39 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 27 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 27, the specification as originally filed does not disclose or describe or give an example of any of the followings: computer program product, computer readable medium, computer executable program code, and computer executable program code.

Regarding claim 38, the specification as originally filed does not disclose or describe or give an example of any of the followings: computer program product, computer readable medium, and computer executable program code.

Claim Objections

2. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As to claim 13, the feature of second wireless communication device establishes a data transfer connection to its own communications network using the user identification data of said first wireless communication device for transferring information between said first wireless communication device and said communications network via said second wireless communication device is already stated in parent claim 1.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-6, 10, 12-15, 17-20, 26, 28-32, 37, 39 are rejected under 35

U.S.C. 102(e) as being anticipated by Bhatia et al, US 2002/0037709 A1. Hereinafter referred to as Bhatia.

Regarding claims 1 and 13, with reference to figure 9, Bhatia discloses a method comprising:

Supplying SIM (Subscriber identification Module) information from a first mobile station 430 (claimed first wireless communication device) to a B2B engine (claimed second wireless communication device) connected to a portal device 420 (claimed second device's own communications network) over a wireless connection, (Claimed second wireless communication device in the second device's own communications network), see paragraphs [0087];

Using the SIM toolkit-enabled mobile station, the SIM toolkit 434 programmed into the SIM card is used to for a new connection, wherein the portal stores all of the supplied user information in a database, and upon storing the information, the portal sends an event notification informing the appropriate B2B engine 364 in charge of the mobile operator of the subscribed user, see paragraph [0084], the B2B engine 364 receives the event notification 370 and processes the information therein comprising an internal validation for the new connection establishment between the portal and the mobile subscriber device, see paragraph [0085]. (Claimed making a data transfer connection by said first wireless communication device through second wireless communication device to communications network using the user identification data of said first wireless communication device for communicating data transfer connection

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information between the first wireless communication device and said communications network via said second wireless communication device).

Regarding claim 2, with reference to figure 8, Bhatia shows the portal 362 (claimed communication network) is in connection with the B2B engine. Further Bhatia with reference to figure 2, shows a cellular network 230 in connection with the B2B engine. Therefore the combination of cellular system 230 with portal 362 reads on the claimed communication network is cellular network. (Claimed said communications network is the closest communications network in which said second wireless communication device is arranged to operate).

Regarding claim 3, Bhatia with reference to figure 2, shows a cellular network 230 in connection with the B2B engine. See paragraph [0043]. (Claimed second wireless communication device is a communication device of a cellular network, and said communications network is a cellular network).

Regarding claim 4, with reference to figure 9, it is clearly shown that the B2B engine is closer to the portal 420 than the mobile device 430, and a connection between the B2B engine with the portal is identified on the basis of data transmitted from the mobile device. See paragraph [0091].

Regarding claim 5, Bhatia discloses providing requested content from the portal through the B2B engine on the basis of the SIM information. See paragraph [0089].

Regarding claim 6, Bhatia discloses the B2B engine establishes a connection to the portal on behalf of the mobile station, see paragraph [0090]. (Claimed second

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wireless communication device establishes a connection to its own communications network on behalf of said first wireless communication device).

Regarding claim 10, with reference to figure 4, Bhatia shows a plurality of ISP (Internet Service Providers) including portal 115 (Claimed particular server of a particular service provider), wherein the information from portal is transmitted to the wireless mobile station through the B2b engine, the connection between the B2B engine and the mobile station being wireless.

Regarding claim 12, Bhatia discloses that upon switching on a mobile station (MS), the serving MSC/VLR (Mobile Switching Center/Visitor Location Register) registers the MS and authorize the MS by communicating with the Home Location Register (HLR) associated with that MS. The HLR then informs the B2B engine, upon this registration and authorization, to forward the preferred information to the mobile station. [0105]. (Claimed second wireless communication device registers to its own communications network using the user identification data of said first wireless communication device).

Regarding claim 14, Bhatia discloses the first mobile station is a PDA, see paragraph [0043].

Regarding claim 17, Bhatia discloses that a user provides various person and preference information to the portal, the information includes the user identification number (MSISDN), mobile operator and various preferences associated with the desired content [0084]. (Claimed user identification data comprises an operator identifier).

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Regarding claim 18, Bhatia discloses the mobile station includes a slot for a SIM card, see unit 436, figure 9. (Claimed first wireless communication device is configured to receive a user data identification module comprising said user identification data of the user of said first wireless communication device).

Regarding claim 19, Bhatia discloses the user information comprises mobile operator identifier, see [0084]. (Claimed user data identification module is a module of a first operator). In addition, Bhatia discloses registering in the B2B engine 310 database). See paragraph [0081]. (Claimed user data identification module is a module of a first operator, with the aid of which module the first wireless communication device can register, via said second wireless communication device, to a network operated by said first operator).

Regarding claims 15, 20, and 39, claims 15, 20 and 39 are apparatus claims and have the same scope of rejected method claims¹ and 17, thus they are subject to the same rejections.

Regarding claim 26, claim 26 is a means claim that have the same scope of method claim¹, thus it is subject to the same rejection, since means are required for performing the steps of method claim 1.

Regarding claims 28-31, claims 28-31 have the same scope of reverse steps of respective rejected method claims 1, 3, 14 and 11, thus they are subject to similar rejections.

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Regarding claims 32 and 37, claims 32 and 37 are apparatus and means and system claims having the same scope of reverse steps of respective claims 1, thus they are subject to a similar rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9, 23, 24, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia in view of Carlson et al, US 2002/00171416 A1. Hereinafter referred to as Carlson.

Regarding claim 7, with reference to figure 4, Bhatia shows a plurality of ISP (Internet Service Providers) including portal 115 (Claimed particular server of a particular service provider), wherein the information from portal is transmitted to the wireless mobile station through the B2b engine, the connection between the B2B engine and the mobile station being wireless. Bhatia doesn't specify the wireless connection between the first mobile and the B2b engine is short range link.

Regarding claims 8 and 9, Bhatia as discussed with regard to claim 7 discloses all the limitations of claim 8, except it does not specify the section between the first wireless communication device and the B2B engine is a local link, and in the section between the second wireless communication device and the communications network,

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the information is communicated over a cellular network connection, as in claim 8 and the local link is short-range link as in claim 9.

Regarding claims 23, 24 and 36, claims 23, 24 and 36 recite that first wireless communication device does not have a long-range communication capability necessary to directly communicate with said network. (In accordance with the specification, this limitation is understood to mean that the first wireless communication device has a short-range link to the second communication device. Bhatia does not specify a short-range link between the mobile station and the B2B engine.

As to claims 7-9 and 23-24 and 36:

Carlson, with reference to figure 1 discloses a first wireless device 114 communicating over a second wireless device 14, the first wireless device communicates with a WAN (Wide Area Network) over the second communication device, wherein the link between the first wireless device and the second communication device is a short-range radio link. Carlson also discloses the first wireless device comprising a SIM module. It would have been obvious to a person of skill in the art at the time the invention was made to implement the short range radio link of Carlson in the system of Bhatia. The system of Bhatia can be modified to connect the second wireless device of Carlson to the B2B engine of Bhatia so that Bluetooth services can be provided in the system of Bhatia (Carlson paragraph [0033]).

5. Claims 11, 27 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia.

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Regarding claim 11, Bhatia as discussed above discloses user identification data being a SIM module data in accordance with the GSM 11.11 standard, Bhatia suggested that other protocols may be alternatively used, [0097]. However Bhatia does not explicitly specify the other protocols are related to an IMSI or IMUI. It would have been obvious to a person of skill in the art at the time the invention was made to use IMIS or IMUI as the suggested protocol for identifying the users in lieu of the SIM information, so that the SIM information can be adapted to established protocol.

Regarding claims 27 and 38, Bhatia discloses a method step as discussed above with regard to claim 1. Bhatia does not specify implementing the method using computer program product, comprising a computer readable medium having computer executable program code for performing the steps of the method. However, using computer program product for executing instructions for performing method steps is well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method of Bhatia using executable instructions by a computer product so to reduce the cost and time of the hardware implementation resulting in more profitability.

Allowable Subject Matter

6. Claims 21-22, and 34-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to claims 1-15 and 17-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See Form PTO-892.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 7-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHMED ELALLAM
Examiner
Art Unit 2616
12/27/07


CHI PHAM
SUPERVISORY PATENT EXAMINER

1/3/08